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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,487	07/24/2003	Ismail I. Walele	FINETEX 3.0-042/DIV	3792
28885	7590	07/21/2004	EXAMINER	
WEINGRAM & ASSOCIATES P.C. P.O. BOX 927 MAYWOOD, NJ 07607			ZUCKER, PAUL A	
			ART UNIT	PAPER NUMBER
			1621	

DATE MAILED: 07/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/626,487

**Applicant(s)**

WALELE ET AL.

**Examiner**

Paul A. Zucker

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 54-97 is/are pending in the application.
- 4a) Of the above claim(s) 79-94, 96 and 97 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 54-74 and 95 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 54-97 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/13/2003</u> . | 6) <input type="checkbox"/> Other: ____  |

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## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 2, drawn to a process for preparing a reduced odor ester, classified, for example, in class 554, subclass 124.
- II. Claims 54-74 and 79-97, drawn to a reduced odor ester, classified, for example, in class 554, subclass 220.
- II. Claims 75-78 drawn to compositions, classified, for example, in class 514, subclass 544.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by the reaction of benzoyl chloride followed by spinning band distillation.

Inventions I and III are unrelated. There is no patentable co-action between a process for making a compound and compositions containing it. The search for one invention would not be coextensive with that for the other invention and the search for both would therefore impose a burdensome search on the Examiner.

Inventions II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the subcombination (alkyl esters of benzoic acid) are known and the patentability of the combination therefore *cannot* depend upon the patentability of the subcombination. The subcombination has separate utility such as a plasticizer.

Because these inventions are distinct for the reasons given above and the search required for each of Groups I, II and III is not coextensive with that required for any other of Group I, II or III, restriction for examination purposes as indicated is proper.

#### ***Election Of Species***

If Applicants elect group II, Applicants are further required to make an election of species.

This application contains claims directed to the following patentably distinct species of the claimed invention as set forth in the Examples on pages 22-52 of the specification.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is

finally held to be allowable. Method and composition claims will be examined for the elected species. Currently, Claims 54-74 and 79-97 are either generic or subgeneric.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

1. During a telephone conversation with Dinah Levitan on 16 July 2004 a provisional election was made with traverse to prosecute the invention of Group II, claims 54-74

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and 79-97, drawn to ester compounds. Applicants further elect as a "specie" C<sub>12</sub>-C<sub>15</sub> alkyl esters, claims 54-75 and 95 readable thereon. Affirmation of this election must be made by applicant in replying to this Office action. Claims 75-94, 96 and 97 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Priority***

2. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows: An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

### ***Specification***

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 54-74 and 95 are rejected under 35 U.S.C. 102(b) as being anticipated by Scala (US 4,322,545 03-1982). Scala discloses (Column 5, lines 1-14) the esterification of benzoic acid, in the presence of an acid catalyst, with Neodol 25 (a mixture of C<sub>12</sub>-C<sub>15</sub> alcohols). The resulting esters each, either alone or in admixture, corresponds to the instantly claimed compound. Scala further discloses (Column 7, line 49- column 8, line 24) that the resulting esters have virtually no odor. The Examiner notes that even though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. See MPEP §2113. Scala therefore anticipates claims 54-74.
5. Claims 54-74 and 95 are rejected under 35 U.S.C. 102(b) as being anticipated by Meyerson et al (Journal of Organic Chemistry, Organic Ions in the Gas Phase. XXVII. Long-Range Intramolecular Interactions in 4-n-Alkyl Trimellitic Esters, 95(18), 1973, pages 6056-6067). Meyerson discloses (Page 6059, column 2, top, Table II, 4<sup>th</sup> entry) dodecyl benzoate that has been purified by distillation at reduced pressure. The Examiner presumes that this material is odorless in light of Meyerson's silence

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with regard to the odor of the dodecyl benzoate obtained. The Examiner notes that even though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. See MPEP §2113. Meyerson therefore anticipates claims 54-74.

### ***Conclusion***

6. Claims 54-97 are pending. 54-74 and 95 are rejected. Claims 75-94, 96 and 97 are held withdrawn from further consideration by the examiner as being drawn to a non-elected invention.

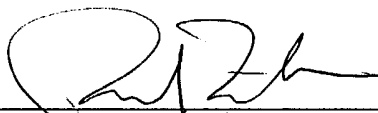
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Zucker whose telephone number is 571-272-0650. The examiner can normally be reached on Monday-Friday 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Paul A. Zucker', is positioned above a horizontal line.

Paul A. Zucker, Ph. D.  
Patent Examiner  
Technology Center 1600